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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,882	01/07/2000	MARIKO EGAWA	TOS-125-USA-	2312

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/478,882

Applicant(s)

EGAWA ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 12-16 and 26-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25, 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted December 19, 2003 is acknowledged.

1. Newly submitted claims 26-31 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. Inventions defined by claims 26-31 and claims 17-25 and 32 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different function. Particularly, claims 26-31 are directed to a method of measuring antioxidant properties of a composition, which is unrelated to the method defined in claims 17-25 and 32 drawn to method of protecting skin.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections 35 U.S.C. § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1617

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 17 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Katsumata et al. (US Patent 5,601,806, of record).

3. Katsumata et al. teach a topical composition comprising thiotaurine compounds and the method of using the same for protecting skin. The concentration of thiotaurine in the composition is higher than 1 mmol/L. See, particularly, column 1, lines 13-20, column 3, lines 43-50, column 4, lines 60-63 and example 1 at column 12, and the claims. As to the particular properties herein recited, i.e., "environmental stress due to exposure of the skin to automobile exhaust gases," note the claims are directed to a method of applying a composition comprising thiotaurine to the skin. Any properties exhibited by or benefits provided by the application of the composition to the skin are inherent and are not given patentable weight over the prior art method which comprises the same steps herein. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicants disclosed and/or claimed are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See, MPEP 2112.01. The burden is shifted to applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of composition containing the same components as instantly claimed. Applicant has not provided any evidence of record to show that the prior art composition do not exhibit the same properties as instantly claimed. Further, a

Art Unit: 1617

person practice the method as claimed by Katsumata et al. would effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

4. Claims 11, 17, 20, 23 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Tominaga (US patent 5,747,049, of record).

5. Tominaga teaches a cosmetic composition comprising thiotaurine compounds and method of using the same for treating or preventing cutaneous aging. See, particularly, the abstract, and the claims. A particular composition disclosed by Tominaga comprises 0.05% of thiotaurine (by weight), UV absorbent, and hydroxycarboxylic acid (citric acid). See formulation example 1, at columns 14-15.

6. As to the particular properties herein recited, i.e., "environmental stress due to exposure of the skin to automobile exhaust gases," note the claims are directed to a method of applying a composition comprising thiotaurine to the skin. Any properties exhibited by or benefits provided by the application of the composition to the skin are inherent and are not given patentable weight over the prior art method which comprises the same steps herein. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicants disclosed and/or claimed are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See, MPEP 2112.01. The burden is shifted to applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of composition containing the same components as instantly claimed. Applicant has not provided any evidence of record to show that the prior art composition do not exhibit the same properties as instantly claimed.

Further, a person practice the method as claimed by Katsumata et al. or Tominaga would

Art Unit: 1617

effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

Claim Rejections 35 U.S.C. § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumata et al. (US Patent 5,601,806, of record).

9. Katsumata et al. teach a topical composition comprising thiotaurine compounds and the method of using the same for protecting skin. The concentration of thiotaurine in the composition is higher than 1 mmol/L. See, particularly, column 1, lines 13-20, column 3, lines 43-50, column 4, lines 60-63 and example 1 at column 12, and the claims.

Katsumata et al. does not teach expressly the particular concentration herein.

10. However, the optimization of a result effective parameter, e.g., effective concentration of an active ingredient, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Further, a person practice the method as claimed by Katsumata et al. or Tominaga would effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

Art Unit: 1617

11. Claims 17-25 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tominaga (US patent 5,747,049, of record).

12. Tominaga teaches a cosmetic composition comprising thiotaurine compounds and method of using the same for treating or preventing cutaneous aging. See, particularly, the abstract, and the claims. The composition may further comprise UV absorbents, or UV blocking agents, wherein the UV absorbents or UV blocking agents may be selected from various organic or inorganic agents. See, particularly, column 2, lines 24-29, column 4, line 56 to column 5, line 40. The examples, column 5, lines 41-43, column 10, lines 51, and claims 4, 10, 11 and 17. The composition may be in various forms and may further comprising other active ingredients. See, particularly, columns 6-11. A particular composition disclosed by Tominaga comprises 0.05% of thiotaurine (by weight), UV absorbent, and hydroxycarboxylic acid (citric acid). See formulation example 1, at columns 14-15.

13. Tominaga does not teaches expressly the particularly concentration of thiotaurine herein, or the combination of thiotaurine with sun blocking agents.

14. However, the optimization of a result effective parameter, e.g., effective concentration of an active ingredient, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. The employment of hydroxycarboxylic acid, UV absorbents and UV blocking agents are obvious because they are all known to be useful in the thiotaurine containing cosmetic composition. Further, a person practice the method as claimed by Katsumata et al. or Tominaga would effectively practice the method claimed herein since people now day are exposed to automobile exhaust gases.

15. No claim is allowable.

Response to the Arguments

Applicants' amendments and remarks submitted December 19, 2003 have been fully considered, but are not persuasive as to the rejections set forth above.

Applicants have correctly point out the issue in the rejections under 35 U.S.C 102: Whether to give any weight to the expression "a method of treating environmental stress due to exposure of skin to automobile exhaust gases, comprising..." The examiner maintains that no weight should be give to this preamble statements. The examiner does treat the claim as method claims, not composition claims. A function, even newly discovered, may not render an old subject matter any patentable weight, regardless the subject matter is a composition, or method. In examining a method claim, the examiner compares the steps involved in the method with those disclosed in the prior art. The steps in the claimed method are exactly the same as those disclosed in the cited prior art: applying a composition containing thiotaurin to the skin of people. It should be well understood that normal people in United State are generally exposed to automobile exhaust gases. The limitation "of treating environmental stress due to exposure of skin to automobile exhaust gases," is not seen to carry any patentable weight. The issue here is not whether an old composition may have a new and patentable utility, but whether the particular function, "of treating environmental stress due to exposure of skin to automobile exhaust gases," can render the old process patentable. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or

Art Unit: 1617

property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.”

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1617

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER
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Art Unit 1617